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In re Application of
BUDIKE
Application No. 09/299,124
Filed: April 26, 1999
Attorney Docket No. 28086.002.00-US

OFFICE OF PETITIONS
DECISION ON PETITION

This is a decision on the renewed petition under 37 CFR 1.137(b) filed December 8, 2003, to revive the above-identified application.

The petition is **dismissed**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time (and fee) under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)."

This application became abandoned January 3, 2002. A Notice of Abandonment was mailed March 8, 2002.

A first petition to revive was filed June 6, 2002, and was dismissed by the decision of August 5, 2002. The decision set a period for renewal, or requesting reconsideration, of two months unless excused by extensions of time under the provisions of 37 CFR 1.136(a). Accordingly, as no extensions of time were obtained under 37 CFR 1.136(a), the renewed petition was due on or before October 5, 2002. See 37 CFR 1.137(e).

The renewed petition was filed December 8, 2003, some 14 months after the deadline of October 5, 2002.

Petitioner, the named inventor and president of Powerweb, the assignee of the entire interest, seeks reconsideration in that (1) he was aware that a reply was to be filed by January 2, 2002, to avoid extension of time fees, but did not direct his former counsel to timely reply to the outstanding Office action, (2) subsequent to October 2, 2001, he did instruct the accountant to send a payment to counsel to cover the costs of preparing and filing the reply, (3) there was some confusion with another Powerweb application such that the payment was never sent, (4) petitioner first learned in May 2002, that this application was abandoned, and authorized the June 2002, filing of the first petition to revive, (5) he learned of the adverse decision of August 5, 2002, on or about November

12, 2002, and believed that there was no further possibility of reviving this application.

As noted in MPEP 711.03(c)III, and 37 CFR 1.137(b), when there is a question as to whether the delay was unintentional, the Director may require further information. The statements made in support of the last petition raised such a question; unfortunately the statements made in support of the present petition do not resolve the question.

There are three periods to be considered during the evaluation of a petition under 37 CFR 1.137(b):

- (1) The delay in reply that originally resulted in abandonment;
- (2) The delay in filing an initial petition pursuant to § 1.137(b) to revive the application; and
- (3) the delay in filing a *grantable* petition pursuant to § 1.137(b) to revive the application. See *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 *Fed. Reg.* 53131 at 53158 (October 10, 1997).

As to item (1) *supra* the record remains unclear as to why petitioner contends the abandonment was unintentional; rather, it appears intentional. Petitioner does not clarify the record by asserting that he "did not direct my attorney to file a timely Response to the Office action." That lack of direction is what is then asserted to be unintentional (see Budike decl. filed December 8, 2003, ¶ 4); but such does not comport with the statement required by 37 CFR 1.137(b). Did applicant, or any one else at Powerweb at any time instruct former counsel not to prepare, not file, or withhold, a response to the Office action mailed October 2, 2001? If so, who; when? Did applicant, or any one else at Powerweb at any time instruct former counsel to prepare, or file, or both, a response to the Office action mailed October 2, 2001, prior to April 2, 2002? If so, who; when? As the statement "confusing the present application with the co-pending application, the payment was never sent" is less than grammatically correct, such likewise does not clarify the issue. Who was confused? What was their position at Powerweb, and that position's relationship to why the reply was withheld? While petitioner contends that he had the ultimate authority, it appears that person or persons actually held the decision making authority as to whether a reply would be made in this case, and exercised that authority by deciding that no reply would be filed. Why was this person or persons able to render petitioner's instructions to the accountant nugatory? Indeed, this person's or persons' actions would appear to be those of the person having the ultimate authority and control to determine whether a reply would be filed vel non, and as such that person is the party whose intent and resultant delay is controlling in this case. See MPEP 711.03(c)III(E), under the caption "Party Whose Delay is Relevant." As such this party's decision and resultant delay would appear

intentional and binding on both petitioner and Powerweb. If not, why not? Still further, petitioner contends that the person or persons who withheld a reply in this case confused this case with another. This speculation is not substantiated, and in any even, such indicates the delay herein was intentional; the delay in filing the reply herein is not rendered unintentional simply because it was misdirected.

As to item (3) supra, the delay in renewing the petition is not shown to be unintentional. That is, petitioner was aware in November 2002, that: (1) the instant application was abandoned, (2) the petition to revive had been aversely decided by the USPTO in August 2002, as such, (3) this application remained abandoned and had not been revived, (4) former counsel had advised petitioner to file a continuation-in-part (CIP) application based on another copending application apparently in lieu of continuing attempts at reviving this application, (5) former counsel was "fired" by petitioner, and (6) no CIP was filed by petitioner. The lack of any concurrent action to renew the petition or seek reconsideration of the decision, or continue to prosecute the "invention" by way of filing the CIP, and the severance of association with former counsel is inconsistent with a finding that the ensuing delay in herein renewing the petition is unintentional. Rather, such is consistent with petitioner's acquiescence to abandonment, not only of this application, but of the invention, as well. Accordingly, there is no adequate basis given or apparent for relaxing the requirement of 37 CFR 1.137(e). See MPEP 711.03(c)III(H).

An adequate showing of unintentional delay must include a showing from Mr. Kenneth Glynn as to why action was not taken to prevent the application from becoming abandoned while the application was under Glynn's control. Petitioner should send a letter (accompanied by a copy of this decision) to Glynn by registered or certified mail, return receipt requested, indicating to Glynn that the USPTO is requesting his assistance in determining the circumstances surrounding the abandonment, revival, and lack of renewed revival of this application, and is specifically requesting Glynn to provide a statement accompanied by a documented showing(s) as to: (1) whether the Office action October 2, 2001, was docketed for reply, (2) with whom at Powerweb, and when, Glynn corresponded or otherwise communicated about (a) preparing, and/or (b) not preparing a reply to the aforementioned action, (3) why counsel, after receipt of the interlocutory decision of August 5, 2002, recommended filing a continuing application of another chain of applications as opposed to renewing this petition. If Mr. Glynn cannot be reached or does not reply, a copy of any receipt showing service on Mr Glynn should be included with any renewed petition.

Petitioner should note that according to USPTO address records maintained for registered practitioners, Mr. Glynn's address is listed as Glynn & Associates PC, 24 Mine Street, Flemington, NJ 08822, and his telephone number is listed as 908-788-0077.

Further correspondence with respect to this matter should be addressed as follows:

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Any inquiries concerning this decision may be directed to the undersigned at (703) 305-8680.



Brian Hearn
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for Patent Examination Policy